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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/561,251

12/19/2005

Koji Fujimoto

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06/24/2009

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Reston, VA 20191

EXAMINER

EOM, ROBERT J

ART UNIT

PAPER NUMBER

1797

NOTIFICATION DATE

DELIVERY MODE

06/24/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/561,251	Applicant(s) FUJIMOTO ET AL.	
	Examiner ROBERT EOM	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lipskier (USP 5,910,286), in view of Kadota (USP 6,366,002 B1).

Regarding claims 10, 11, and 15-17, Lipskier teaches a chemical sensor (Fig. 4A) comprising a surface acoustic wave transducer with a piezoelectric substrate, on which are two interlocking series of gold electrodes (SE1 and SE2), and a sensitive layer (L) deposited on top of and covering the electrodes

Lipskier does not explicitly disclose the surface acoustic wave transducer being a rotated Y-cut LiTaO_3 substrate having Euler angles of (0° , 120° to 140° , $0^\circ \pm 5^\circ$) and the electrodes having a normalized thickness of about 3.0% to about 5.0%, the normalized thickness being determined by normalizing the thickness of the electrodes by the wavelength of the surface acoustic wave

Kadota teaches a surface acoustic wave device comprising: a rotated Y-cut LiTaO_3 substrate having Euler angles of (0° , 120° to 140° , $0^\circ \pm 5^\circ$) (C4/L40-42, see: piezoelectric substrate); electrodes, principally containing Au, and arranged on the LiTaO_3 substrate to excite a surface acoustic wave (C4/L45); wherein the electrodes have a normalized thickness of about 3.0% to about 5.0%, the normalized thickness being determined by normalizing the thickness of the electrodes by the wavelength of the surface acoustic wave (C4/L50, see: 5% or less).

Lipskier and Kadota are analogous because both references are directed to SAW based microdevices.

It would have been obvious to one having ordinary skill in the art at the time of the invention to substitute a LiTaO_3 surface acoustic wave device in the chemical sensor of Lipskier, as taught by Kadota, since doing so causes the propagation loss to become substantially zeros even where the film thickness is extremely small, thereby

making the conditioning range of the frequency trimming much wider than conventional surface acoustic wave devices (Kadota: C3/L30-37).

Regarding claims 12-14, modified Lipskier discloses all of the claim limitations as set forth above. Lipskier further discloses a bonding layer, placed between the reaction membrane and the electrodes, and arranged to improve the bond between the reaction membrane and the electrodes (C6/L56-C7/L19); a protective layer, placed between the bonding layer and the electrodes, lying over the electrodes and regions outside the electrodes (Fig. 4A, see: intermediate material L1; C5/L22-33).

Regarding claim 18, modified Lipskier discloses all of the claim limitations as set forth above. Lipskier further discloses the reaction membrane includes a substance bound to a biological substance that is a target substance and the mass applied to a surface of the substrate of the surface acoustic wave sensor is varied due to the bind of the biological substance to the reaction (C6/L17-21).

Response to Arguments

5. Applicant's arguments, see pg 6 of applicant's reply, filed 03/17/2009, with respect to the rejection(s) of claim(s) 10-18 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Lipskier (USP 5,910,286).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Li et al. (USP 5,418,058), teaches SAW chemical microsensors utilizing a chemically selective cyclodextrin film; Baer et al. (USP 5,283,037) teaches a LiTaO₃ SAW chemical sensor.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT EOM whose telephone number is (571)270-7075. The examiner can normally be reached on Mon.-Thur., 9:00am-5:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tony G Soohoo/
Primary Examiner, Art Unit 1797

/R. E./
Examiner, Art Unit 1797